

PATENT
Docket No. 180.0003 0103

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): HANSON et al.)	Group Art Unit: 1634
)	
Serial No.: 09/814,252)	Examiner: F. Lu
Confirm. No.: 6198)	
)	
Filed: 21 March 2001)	
For: PRIMERS FOR USE IN DETECTING BETA-LACTAMASES		

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Restriction Requirement mailed 19 November 2002, Applicants elect, with traverse, Group IV (claims 11, 56, and 57), drawn to a diagnostic kit for detecting a PSE1, PSE4, or CARB3 family beta lactamase and related primers.

Applicants respectfully request reconsideration and withdrawal or modification of the restriction requirement. It is respectfully submitted that the inventions as claimed can be readily evaluated in one search without placing undue burden on the Examiner. That is, all the claims are so interrelated that a search of one group of claims will reveal art to the others.

Were restriction to be effected between the claims of Groups I to XIII, a separate examination of the claims in these 13 groups would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I to XIII would have to be as rigorous as when only the claims of Group IV, for example, were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicants submit that for restriction to be

effected between the claims in Groups I to XIII, it would place an undue burden by requiring payment of 12 separate filing fees for examination of the nonelected claims, as well as the added costs associated with prosecuting 13 applications and maintaining 13 patents.

Additionally, Applicants respectfully request that Group XIII, drawn to a method for identifying a beta-lactamase in a clinical sample (independent claim 17), and claims including the elected PSE1, PSE4, or CARB3 family beta lactamase and related primers depending therefrom (claims 37 and 38), be examined with Group IV. Applicants submit that although the Examiner indicated prior art that could be used to reject claim 17, Group XIII, including claims 17, 37, and 38, should be examined with Group IV, as these claims recite and/or encompass the primer pair recited in the claims of Group IV. Furthermore, Applicants reserve the right to address any art rejections the Examiner may make in any subsequent Actions.

Applicants elect, with traverse, the following primer pair per the species election. This election is with traverse to the extent that it is understood that (a) the requirement will be withdrawn upon the finding of an allowable genus; and (b) any species withdrawn from consideration will be transferred to the elected subject matter unless it is found patentably distinct from the elected or allowed claims. Applicants traverse on the grounds that the generic claim includes sufficiently few species that a search and examination of all the species at one time would not impose a serious burden on the Examiner.

Primer Name: (SEQ ID NO:32) 5' - CTC GAT GAT GCG TGC TTC GC - 3'

Primer Name: (SEQ ID NO:33) 5' - GCG ACT GTG ATG TAT AAA CG - 3'

These primer pairs are recited in claims 11, 38, and 57, and are also encompassed by claims 17, 37, and 56.

Applicants' Representatives reserve the right to pursue examination of the non-elected claims in continuation or divisional applications.

Applicants respectfully request reconsideration of the restrictions in this case and submit that the inventions as claimed can be readily evaluated in one search without placing undue burden on the Examiner.

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The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if there are any questions regarding this Response or if prosecution of this application may be assisted thereby.

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 17th day of December, 2002, at 4:20 PM (Central Time).

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PATENT TRADEMARK OFFICE

Dec. 17, 2002
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